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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,608	02/14/2001	Milton Smith	0879-0299P	9767

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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
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BAYERL, RAYMOND J

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 03/24/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/782,608

Applicant(s)

SMITH, MILTON

Examiner

Raymond J. Bayerl

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 - 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

1. The abstract of the disclosure is objected to because the claimed invention is directed only to a “computer program”, while the abstract indicates that the invention is also a “system, article of manufacture, operator-system interface and propagated signal”. Correction is required. See MPEP § 608.01(b).

2. The disclosure is also objected to because of the following informalities:

At page 2, in the brief description of the drawings, applicant indicates “Figure 6”, “Figure 8” and “Figure 10”, while the actual drawings contain figs 6A, 6B; 8A, 8B; 10A, 10B, respectively.

At pages 19 – 20, please note that reference numerals “1106-1” – “1106-3” do not properly correspond to the figures—might applicant have intended “1108-1” – “1108-3” (see fig 11)?

Appropriate correction is required.

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1 - 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A “computer program” that comprises merely a number of specified “module” components is a computer program *per se*, in that it is not fixed to a tangible computer readable medium, computer hardware, etc. The four statutory classes of invention under 35 USC 101 do not provide for such a claim.

Claim 13, in which "said computer program is embodied as an article of manufacture", does not properly restrict the "computer program" to a statutory "article of manufacture", despite the phrase being recited.

Claim 14, in which "said computer program is embodied as a propagated signal", also does not place the invention into the statutory classes. A "propagated signal", when this term is given a reasonably broad interpretation, is merely a conveyance afforded to pure information, as when the "computer program" is provided for use. A specific limitation to "process, machine, manufacture" is not given.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 – 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frey et al. ("Frey"; US #6,369,908 B1) and Yager et al. ("Yager"; US #5,983,236).

As per sole independent claim 1's use of "a processor for carrying out image processing" for the purpose of "outputting the image in at least one of" a "second plurality of different formats", please note that Frey's PHOTO KIOSK similarly discloses that a cpu is used to capture an electronic image, to which the user can selectively add to the electronic image and save the electronic file on a removable electronic storage device (Abstract). This storage device, as indicated at col 1, lines 60 – 64, can be a computer diskette, CD, tape or similar item. Responsive to a "user-generated service request" (see col 3, lines 19 – 42), the captured image is sent to the cpu (col 3, lines 43

– 67), which displays the captured image onto the monitor 13, thereby allowing the user to review the captured image. From the display format, Frey must convert to one of the disparate formats for the particular storage device that is selected.

Frey's **explicit** disclosure appears to be that of a single-source image acquisition arrangement, via a digitizing camera at the KIOSK location, and not one that uses “an input module for receiving images in a first plurality of different formats” for conversion to the “common format” of the monitor.

However, Yager, in PROVIDING A MULTIMEDIA PRESENTATION, works with combinations of audio, video, still images, and text which are represented by binary data files (Abstract). In so doing, any of the various audio, video, **still image** and text data formats is supported. As described at col 3, lines 7 – 25, in building a data file from component data, a file type identifier is associated with the synchronized output (see also col 2, lines 42 – 65).

Thus, it would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to develop a formatted output from a common, internal format for image processing, as per Frey, but while sourcing the image data from a variety of input formats as per Yager, for this expands the potential for a Frey user to develop a useful finished product, as with a KIOSK that supports a user interface.

As per claim 2, the Examiner notes that the “first conversion module” operates with “one of the first plurality of different formats”, which in claim 2 are limited so as to “include” a list of industry-standard image storage formats. Yager reads upon a claim so constructed, by disclosing a decoder of still image data adapted for use with the GIF,

TIF, or BMP formats, which could be substituted for the JPEG decoder of the present embodiment (col 7, lines 37 – 60).

Similarly, when claim 3 elaborates upon “at least one of a second plurality of different media”, presenting a list of optional formats in so doing, it still reads upon the CD, floppy disks, and the like that are supported by Frey. A similar line of reasoning applies to claim 6.

As per claim 4, the “image processing performed by said processor that includes...”, followed by a listing that includes “preview corrected images”, on the basis of “at least one corresponding user-generated service request”, can be reasonably interpreted to read upon the cpu in Frey, which displays the photographic image with the superimposed banner on the monitor (col 4, lines 23 – 32). This “service request”, as seen in Frey, is “via a plurality of screen displays” on the monitor (claim 7), and may constitute at least “a new order” and an “image display” (claim 8). In Frey’s operation, “images are stored by said computer program” locally, before their ultimate disposition (claim 11), and the composition thereby created, as also in the case of Yager’s output, is “an order file” (claim 12).

Claim 5’s “second plurality of different formats”, of which an option is “JPG”, is suggested by the file-assimilation of JPEG still image data format sources in Yager, should they be incorporated into the recorded output in combination with Frey.

As per the “network connected” “user” of claim 9, please note further that Frey specifically works with electronic transmission, such as over the Internet or other similar network of computers (col 1, lines 54 – 59). The KIOSK of Frey may be remotely

Art Unit: 2173

accessed (col 6, lines 34 – 40). As further seen in Yager's use of a remote digital computer system that interacts with a server (col 2, lines 16 – 41), it can be seen that "image processing" functions were routinely performed over a "network" at the time of applicant's invention. A similar line of reasoning applies to the "remote terminal" of claim 10.

The Frey/Yager combination, in which disparately-sourced images are composited into an output having a specific format, requires that the "computer program" responsible will appear as "an article of manufacture" (claim 13), provided "as a propagated signal" (claim 14).

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The remaining US Patent documents made of record (see attached form PTO-892) relate to the handling and output direction of acquired images.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Bayerl whose telephone number is (703) 305-9789. The examiner can normally be reached on M - F from 10:00 AM to 5:00 PM.


9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (703) 308-3116. All patent application related correspondence transmitted by FAX **must be directed** to the central FAX number (703) 872-9306.

Serial Number: 09/782,608

Page 7

Art Unit: 2173

10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



RAYMOND J. BAYER  
PRIMARY EXAMINER  
ART UNIT 2173

11 March 2004